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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,583	10/02/2003	Jean-Christophe Bandini	127-0008-4	2291
22120	7590	04/02/2008	EXAMINER	
ZAGORIN O'BRIEN GRAHAM LLP			SHAN, APRIL YING	
7600B NORTH CAPITAL OF TEXAS HIGHWAY				
SUITE 350			ART UNIT	PAPER NUMBER
AUSTIN, TX 78731			2135	
			MAIL DATE	DELIVERY MODE
			04/02/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/678,583	BANDINI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	APRIL Y. SHAN	2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 December 2007 and 23 July 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
  - 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19 and 22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 

Paper No(s)/Mail Date 10/07 and 1/08.
- 4) Interview Summary (PTO-413)
 

Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-19 and 22 have been examined.

***Election/Restrictions***

2. Applicant's election with traverse of Species I (Claims 1-8) in the reply filed on 5 December, 2007 is acknowledged. The examiner respectfully and carefully reviewed the Applicant's arguments for traversing the restriction requirement; in response the examiner withdraws the restriction **in part** (MPEP 821.01). Claim 22 is now the generic claim and claims 9-19 are rejoined with claims 1-8 as species I. Claims 20-21 are now the species II because in claims 20-21, a plurality of policy managers comprising the combined selectable policies of virus policies, source/destination policies, content policies and signature policies, which are distinct from Species I (filter e-mails by only validating sender's signature). Therefore, claims 1-19 and 22 have been examined and claims 20-21 are withdrawn from consideration.

The examiner acknowledges that the Applicant stated that the independent claims are each of **substantially different**.

The Applicant is also invited to read MPEP 808.01(a), in which it set forth "Election of species may be required prior to a search on the merits (A) in applications containing claims to a plurality of species **with no generic claims**". Further, the examiner welcomes the Applicant to point out where in the new rules or MPEP that the examiner is not able to make restriction requirement to applications with less than or equal to five independent claims or total of twenty-five claims.

***Priority Argument***

3. Applicant claimed that the current application is a continuation-in-part of U.S. patent application Ser. No. 09/967,117 which is a continuation of U.S. patent application Ser. No. 09/180,377, entitled "E-MAIL FIREWALL WITH STORED KEY ENCRYPTION/DECRYPTION," Now U.S. Pat. No. 6,609,196 filed Nov. 3, 1998, which is a national stage patent application filed under U.S.C. .sctn.371, based on PCT/US98/15552 entitled "E-MAIL FIREWALL WITH STORED KEY ENCRYPTION/DECRYPTION," filed on Jul. 23, 1998, which claims priority to U.S. Provisional Application No. 60/053,668, entitled "ELECTRONIC MAIL FIREWALL," filed Jul. 24, 1997, the examiner respectfully disagrees.

Examiner had reviewed carefully the parent application (09/967,117), now U.S. Patent No. (7,162,738) and the Applicant's argument on page 9 of the remark. It appears to the examiner that the argument in the first paragraph on page 9 is a conclusion instead of mapping of the claims with the parent disclosure and the second paragraph is more towards the non-elected claims 20-21.

Therefore, the parent application (09/967,117) only discloses signature, for example, in col. 7, lines 9-10 and admitted prior art about S/MIME protocol provides digital signature is disclosed in col. 8, lines 12-13. However, the examiner discovered at least three claim limitations, the e-mail relay extracting signature data from the message, the e-mail relay attempting to validate the signature data and the e-mail relay performing an action selected from a set that includes at least (i) allowing the message

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to flow toward the intended recipient via the e-mail server and (ii) diverting the message away from the intended recipient, wherein the selection is based at least in part on a result of the validation attempt in the independent claims 1, 8 and 22 of the current application are **not supported** by the parent application (09/967,117). Therefore, the examiner will not grant the priory date as claimed. The effective filling date of the current application is the filling date of the current application, which is 02 October 2003.

***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Correction of the following is required: "media" of claim 22 lacks antecedent basis in the specification.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 8, it is a dependent claim of claim 10. However, claim 10 is a system claim. Further, "wherein the categories..." is being recited. However, it lacks of antecedent basis.

In order to exam on the merit of this claim, the examiner assumes claim 8 depending on claim 7.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 22** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 22 recites a media. However, the original disclosure does not expressly define/discloses a media. To a person with ordinary skill in the art, a media can include communication media, such as signal, carrier wave and etc. This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter. **Please note any amendment should be commensurate with its corresponding disclosure.**

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-4, 7-11, 13, 17-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ji (U.S. Patent No. 5,623,600) and in view of Haynes (U.S. Patent No. 6,161,181)

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As per claims 1 and 9, Ji et al. discloses a method/system for controlling reception of messages in an e-mail network, each message is associated with a message sender, comprising:

providing an e-mail relay the e-mail relay interposed along a message communication path associated with a public network and an e-mail server of the e-mail network ("...on a computer network includes a File Transfer Protocol (FTP) proxy server, for controlling the transfer of files and Simple Mail Transfer Protocol (SMTP) proxy server for controlling the transfer of mail messages through the system...The FTP proxy server and SMTP proxy server scan all incoming and outgoing files and messages..." – e.g. abstract. Please note FTP proxy server and SMTP proxy server correspond to Applicant's e-mail relay);

the e-mail relay receiving a message intended for a recipient associated with the e-mail network (e.g. col. 2, line 61 – col. 3, line 16);

Ji further discloses FTP proxy server and SMTP proxy server performs signature scanning process by extracting signature data from the message ("...a program the performs a version of signature scanning virus detection..." - e.g. col. 7, lines 29 – 63 and claim 6) and attempting to validate the signature data (e.g. col. 7, lines 29-63 and claim 6).

Ji does not expressly disclose the signature data is sender identity (sender's signature) as intended by the Applicant.

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However, this well known feature is disclosed in Hayness (e.g. col. 2, lines 57-67 and col. 8, lines 50-62). In Ji, e-mail scanning is at the gateway and in Hayness, a Trusted Intermediary is implemented in the secure electronic transactions, such as e-mail communication. It would have been obvious to a person with ordinary skill in the art at the time of the invention to combine Hayness's signature data is sender identity with Ji since verifying the sender's identity is well known in the field to authenticate the identity of the sender in order to confirm the message originated from the sender has not been altered.

Further, Ji – Hayness discloses the e-mail relay performing an action selected from a set that includes at least (i) allowing the message to flow toward the intended recipient via the –mail server and (ii) diverting the message away from the intended recipient, wherein the selection is based at least in part on a result of the validation attempt (e.g. Ji, col. 2, line 61 – col. 3, line 16 and Hayness, col. 2, lines 57-67, col. 8, lines 50-62 and col. 4, line 50- col. 5, line 48).

As per **claim 2**, Ji – Haynes disclose a method as applied above in claim 1. Ji – Haynes further discloses wherein the e-mail relay further classifying the message sender based on the signature data and selecting the action at least in part based on the classification (Ji, col. 2, line 61 – col. 3, line 16 and Hayness, col. 2, lines 57-67, col. 8, lines 50-62 and col. 4, line 50- col. 5, line 48).

As per **claim 3**, Ji - Haynes discloses a method as applied above in claim 1.

Haynes further discloses wherein the e-mail relay validates the signature data by employing a validation authority (e.g. col. 5, lines 15-48).

As per **claim 4**, Ji – Haynes disclose a method as applied above in claim 1. Ji further discloses wherein said at least one predetermined action comprises allowing the message to proceed to at least one recipient (e.g. col. 2, line 61 – col. 3, line 16).

As per **claims 7 and 10**, Ji – Haynes further discloses for at least certain categories of e-mail messages received, passing only those e-mail messages for which sender identity is validated based on the extracted signature data (Ji, col. 2, line 61 – col. 3, line 16 and Hayness, col. 2, lines 57-67, col. 8, lines 50-62 and col. 4, line 50- col. 5, line 48).

As per **claims 8 and 11**, Ji further discloses wherein the categories include one or more of: e-mail messages having one or more attachments and e-mail messages having one or more executables (e.g. col. 7, lines 29-40).

As per **claims 17-18**, Ji further discloses wherein the intended recipient is an internal recipient and wherein the intercepted e-mail message is inbound from the network to the e-mail server or wherein the intended recipient is an external recipient and wherein the intercepted e-mail message is outbound from the e-mail server to the network (e.g. abstract).

As per **claim 19**, Ji - Haynes further discloses comprising one or more of e-mail server and the validation authority (Ji, e.g. abstract and Haynes, e.g., fig. 1A and 1B and col. 5, lines 15-48)

As per **claim 13**, it is rejected using the same rationale as rejecting claims 1 and 2 above.

As per **claim 22**, Ji – Haynes discloses the claimed method of steps as applied above in claim 1. Therefore, Ji - Haynes discloses a computer program product embodied in the media for carrying out the method of steps.

12. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ji (U.S. Patent No. 5,623,600) and in view of Haynes (U.S. Patent No. 6,161,181) as applied to claims 1 and 9 above, and further in view of '943 (U.S. Patent No., 5,889,943)

As per **claims 5 and 14**, Ji – Haynes does not expressly disclose quarantining a diverted e-mail message. However, this well known feature is disclosed in '943 (fig. 15 and col. 20, lines 34 and 41-63). It would have been obvious to a person with ordinary skill in the art to combine such well known feature of '943 with Ji – Haynes motivated by enhancing e-mail security by warning and alerting the receipt as taught in '943.

13. Claims 6, 12 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ji (U.S. Patent No. 5,623,600) and in view of Haynes (U.S. Patent No. 6,161,181) as applied to claims 1 and 9 above, and in view of '943 (U.S. Patent No., 5,889,943) and further in view of examiner's official notice.

As per **claims 6, 12 and 15-16**, Ji – Haynes does not expressly disclose discloses quarantining a diverted e-mail message until the sender completes an

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enrollment process. However, '943 discloses quarantining a diverted e-mail message (fig. 15 and col. 20, lines 34 and 41-63). It would have been obvious to a person with ordinary skill in the art to combine such well known feature of '943 with Ji – Haynes motivated by enhancing e-mail security by warning and alerting the receipt as taught in '943. Further, the examiner takes official notice that at the time of the invention it would have been obvious to a person with ordinary skill in the art initiates a sender enrollment process for sender identity is unvalidated, quarantine a diverted e-mail message until the sender completes an enrollment process successfully, the e-mail relay associates a valid signature with a diverted e-mail message and passes the previously quarantined e-mail message since Ji – Haynes discloses in the above claims that verifying sender's identity in order to confirm the message originated from the sender has not been altered in the e-mail communication is well known in the art. When a sender without a sender's identity needs to be enrolled in order to send out a quarantined message originated by the sender and this feature is common knowledge in the art and to produce predictable results.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO-892)
15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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18 February 2008  
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